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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91165809
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

<u>In re Application, Serial No. 76/572,253</u>)	
TriForest Enterprises, Inc.)	
)	Opposition No. 91165809
Opposer,)	
v.)	
)	
Nalge Nunc International Corporation)	
)	
Applicant-Respondent.)	
_____)	

Commissioner for Trademarks
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

**APPLICANT NALGE NUNC INTERNATIONAL CORPORATION'S OBJECTIONS TO
AND MOTION TO STRIKE PORTIONS OF OPPOSER'S REPLY BRIEF
AND
MOTION FOR SANCTIONS**

I. INTRODUCTION

Applicant Nalge Nunc International Corporation ("Nalge") submits this Motion in accordance with Rules 2.122 and 2.126(d) of the Trademark Rules of Practice and Sections 527.02, 539 and 707 of the Trademark Trial and Appeal Board Manual of Procedure ("T.B.M.P."). Opposer TriForest Enterprises, Inc.'s ("TriForest") Reply Brief, laden with sheer speculation, unsupported attorney argument, and spurious accusations against Nalge (as was TriForest's opening Trial Brief), once again confirms that TriForest's motive for this opposition proceeding is a far cry from good faith. Accordingly, Nalge moves the Trademark Trial and Appeal Board ("Board") to strike portions of TriForest's Reply Brief. Nalge also moves the

Board for relief from TriForest's conduct during this opposition proceeding, in the form of sanctions, as it deems warranted.¹

II. BACKGROUND

TriForest's Reply Brief, like its Trial Brief, is wholly based upon mere attorney argument lacking any evidentiary support. It is also based upon exhibits that were not properly entered during the trial testimony period, as well as exhibits that have not been properly authenticated. To make matters worse, TriForest quoted in its Reply Brief testimony from a deposition transcript that has been designated confidential, in violation of the Protective Order entered in this matter and Rule 2.126(d).

In fact, TriForest's Reply Brief is so heavily laden with impermissible and unsupportable arguments and exhibits, Nalge is somewhat at a loss as to how to coherently address each unsupported argument without simply arguing that TriForest's Reply Brief should be stricken in its entirety. Nonetheless, Nalge will attempt to address the numerous deficiencies in TriForest's Reply Brief in the following order: (a) arguments that are unsupported by any evidence; (b) exhibits that were not properly entered during the trial testimony period and exhibits that have not been properly authenticated; and, (c) testimony that has been designated confidential and violates the Protective Order entered in this matter. Next, in Section IV, Nalge will address the spurious matter that should both be stricken from TriForest's Reply Brief and sanctioned pursuant to Rules 11(b) and 12(f) of the Federal Rules of Civil Procedure.

¹ The instant Motion is likewise brought pursuant to Rules 11(b) and 12(f) of the Federal Rules of Civil Procedure, which provide sanctions for, among other things, pleadings filed with allegations lacking evidentiary support, as well as immaterial, impertinent, or scandalous matter. Accordingly, Nalge represents it has served the instant Motion upon counsel for TriForest 21 days prior to filing. T.B.M.P. § 527.02.

III. ARGUMENT – OBJECTIONS AND MOTION TO STRIKE

A. TriForest’s Arguments Are Unsupported By Any Evidence

The bulk of TriForest’s Reply Brief is based upon factually unsupported assertions, which should be disregarded. (*See* T.B.M.P. § 707.03: “Statements made in pleadings cannot be considered as evidence on behalf of the party making them; such statements must be established by competent evidence during the time for taking testimony.”) For example, TriForest argues that:

Customers who are in the lab market are well aware that this is a Boston round bottle with several utility functions. Lab media suppliers use these bottles for the ease of labeling with an applicator, rolling cultures, and the simplicity of its design for packaging that has been established as ‘traditional lab bottles.’ Customers in the lab were first to purchase these bottles for hiking and outdoor activities when they realized it was Nalgene² brand also. The customers now buy Nalgene brand bottles, because Nalgene is an established name brand in laboratory market as well as the consumer water bottle market. As a result many consumers know and purchase Nalgene hydration products that include other designs as well as the stated Boston Round.

Opposer’s Reply Brief, at pp. 1-2.

There is not a shred of evidence that would support any of these arguments. By way of example only, there is no evidence that would suggest, as represented by TriForest, that “[c]ustomers who are in the lab market are well aware that this is a Boston round bottle...” Such a representation would necessarily require testimony from “customers who are in the lab market” that would suggest that they are of the impression that “this is a Boston round bottle.” However, there is no such testimony here. Rather, there is only attorney argument, which should be

² TriForest appears disinterested enough with this opposition proceeding to incorrectly refer to Applicant as “Nalgene.” Nalgene is a registered trademark of Nalge, not its corporate name. Therefore, Applicant is appropriately referred to as “Nalge.” Nalge attempted to bring this to TriForest’s attention in its Trial Brief, apparently to no avail. (Applicant’s Trial Brief, at fn. 3).

stricken. T.B.M.P. § 707.03; *Plus Products v. Physicians Formula Cosmetics, Inc.*, 198

U.S.P.Q. 111, 113 (TTAB 1978)(“However, in view of the fact that [TriForest] has submitted no testimony or other evidence in support thereof, [TriForest’s] remarks cannot be considered.”)

There are numerous other examples of unsupportable accusations made by TriForest in its Reply Brief:

The Boston round bottle is the most common bottle with many utility applications used in laboratory and life Science industry...(Opposer’s Reply Brief, at p. 2).

The same caps have been available with connector on water canteens since World War II as seen in the exhibits. The same polycarbonate bottle being claimed as a trademark is sold in the laboratory market as a media and reagent bottle. Nalgene’s market position strategies place the bottles without a tether in the lab market as Boston round media bottles as seen on the Nalgene Labware page. These are the same bottles that are being marketed here...*Id.* at p. 2.

The Boston Round Bottle is commonly used in the lab market for roller-cutting and roller label applicator. TriForest also sells Boston Round Bottles with Tether caps in all its market without any distinction to the consumer. The tethered cap bottles are available in the lab market...*Id.* at pp. 3-4

For the plastic resin, the Boston round bottle claimed is the simplest bottle to manufacture. *Id.* at p. 4.

Also, customers are likely to pay higher prices on a product that is public domain, and clearly has no difference in material (resin used) and the properties of the resin. *Id.* at p. 5.

There is no evidence of record that would support any of these arguments.

Consequently, they should be stricken. T.B.M.P. § 707.03; *Plus Products*, 198 U.S.P.Q. at 113.

B. TriForest Improperly Attached Exhibits To Its Reply Brief That Were Not Entered During The Trial Testimony Period

In its Reply Brief, TriForest makes reference to a design patent and several trademark registrations that have not been entered into evidence, during the trial testimony period or otherwise. In addition, TriForest attached several exhibits to its Reply Brief. For example, TriForest referred to U.S. Design Patent D311,681 (p. 3), U.S. Trademark Registration Nos. 2,857,283 and 2,857,279 (p. 3), “several trademarks on various functional elements...” (p. 3), and “other designs (refer to N-Gen)” (p. 3). TriForest also attached four exhibits to its Reply Brief that it described as “Nalgene labware” (p. 2) and “applicant’s sales of the alleged trademark in the laboratory market” (p. 6).

The law requires that each of these references, exhibits, and arguments based upon them be stricken from the record because they were not properly entered during the trial testimony period and have not been properly authenticated. *Angelica Corp. v. Collins & Aikman Corp.*, 192 U.S.P.Q. 387 (TTAB 1976)(“Evidence submitted by opposer for the first time with its brief has not been considered because it was not regularly made of record during its trial testimony period in chief or rebuttal testimony period.”); *Binney & Smith Inc. v. Magic Marker Indus., Inc.*, 222 U.S.P.Q. 1003 (“...some of the exhibits consisted of opposer’s promotional materials and hence are not proper subject matter for introduction under Rule 2.122(e)...Aside from the fact that material attached to a brief on the case be given no consideration unless it has been properly made of record during the testimony period of the offering party...”); *Plus Products*, 198 U.S.P.Q. at 112 (“[TriForest’s] exhibits attached to its brief cannot be considered since they were not made of record during [TriForest’s] trial period.”); *Ortho Pharmaceutical Corp. v. Hudson Pharmaceutical Corp.*, 178 U.S.P.Q. 429 (TTAB 1973)(“Much of [TriForest’s]

brief relies on matters which cannot be considered herein since it is well established that documents attached to the brief of a party are not in evidence.”)

Nalge objects to TriForest’s reference to these materials and to all of TriForest’s arguments based upon them. These materials also have not been properly authenticated under 37 CFR § 2.122(e), and as required under the Federal Rules of Evidence. Therefore, Nalge requests that the Board strike these materials.

C. TriForest Violated The Protective Order Entered In This Matter By Referring To Confidential Testimony

At page 5 of its Reply Brief, TriForest quoted from the deposition testimony of Margaret Gregory, Nalge’s Director of Consumer Products Business, Sales and Marketing. Margaret Gregory’s testimony has been designated “Confidential” pursuant to the Protective Order entered in this matter on April 10, 2006. TriForest’s reference to this testimony violates the Protective Order as well as Rule 1.126(d). Accordingly, Nalge requests that TriForest’s reference to Margaret Gregory’s testimony be stricken from the record.

IV. ARGUMENT – MOTION FOR SANCTIONS

A. TriForest Violated Rules 11(b) and 12(f) of the Federal Rules of Civil Procedure

Rule 11(b) of the Federal Rules of Civil Procedure provides:

By presenting to the court (whether by signing, filing, submitting, or later advocating) a pleading, written motion, or other paper, an attorney...is certifying that to the best of the person’s knowledge, information, and belief, formed after an inquiry reasonable under the circumstances,...the allegations and other factual contentions have evidentiary support...

Nalge submits that the allegations and factual contentions made by TriForest in its Reply Brief (as well as its Trial Brief) do not have a shred of evidentiary support. A sampling of TriForest's unsupportable allegations include:

Customers who are in the lab market are well aware that this is a Boston round bottle with several utility functions. (Opposer's Reply Brief, at pp. 1-2).

The same caps have been available with connector on water canteens since World War II...*Id.* at p. 2.

The same polycarbonate bottle being claimed as a trademark is sold in the laboratory market as a media and reagent bottle. *Id.* at p. 2.

For the plastic resin, the Boston round bottle claimed is the simplest bottle to manufacture. *Id.* at p. 4.³

None of these allegations have any evidentiary support whatsoever, as required by Rule 11.

Nalge also submits that TriForest has violated Rule 12(f), which prevents the use of "any redundant, immaterial, impertinent, or scandalous matter." Civ.R. 12(f). Generally speaking, TriForest has used its Reply Brief as an opportunity to take unwarranted shots at Nalge and its business. TriForest has no legitimate reason for making the following accusations, and sanctions should be levied against TriForest accordingly:

From the record, the Board can see that Nalgene has a history of informing its distributors that its products are patented, and trademarked...*Id.* at p. 4

³ Nalge went to great expense to demonstrate in this opposition proceeding that the method required to manufacture Nalge's products bearing Nalge's mark is no cheaper or simpler than manufacturing a functionally equivalent drinking bottle. Nalge deposed and offered into evidence the testimony of Mr. Samuel Belcher and Mr. Paul Comeau, who collectively have over 70 years experience in design and manufacture of plastics and plastic parts, to demonstrate this point. TriForest attempts to counter this substantial testimony with unsupported and unsupportable attorney argument.

This creates a chilling effect on free competition and as a result, sellers, distributors, and marketers are deterred from dealing in a product that is really a public domain design. Nalgene has used this strategy...*Id.* at p. 4. (emphasis added).

Nalgene is a large company that is trying to use its size to monopolize a functional public domain design. *Id.* at p. 5.

TriForest has turned its Reply Brief into carte blanche to tarnish the reputation of Nalge, an exceptional company, as seen by Nalge's customers, distributors, and even its competitors. TriForest's accusations to the contrary have no place in TriForest's Reply Brief, are far from relevant to the issues involved in this opposition proceeding, and should be stricken. Based on the serious nature of the accusations, which are undeniably a cavalier attempt to tarnish Nalge's name, Nalge submits that sanctions should also be levied against TriForest. As described below, TriForest's conduct during the course of this opposition proceeding further supports an award of sanctions against TriForest.

B. TriForest Engaged In No Written Discovery

TriForest filed its Opposition on June 30, 2005, based on the allegations that Application Serial No. 76/572,253 is functional and lacks secondary meaning. TriForest undertook no written discovery to demonstrate the veracity of its allegations. Forced to defend its application against TriForest's allegations, Nalge prepared and served upon TriForest extensive written discovery, at significant expense to Nalge.

C. TriForest Engaged In Virtually No Trial Testimony

TriForest also took virtually no action during the trial testimony period, other than taking a mere 43 pages of deposition testimony from its employee, Mr. Lin (for which Nalge was forced to incur great expense by having counsel travel from Ohio to California). Once again

forced to defend its application against TriForest's allegations, Nalge scheduled and took five depositions during its trial testimony period. These depositions forced counsel for Nalge to travel from Ohio to: Rochester, New York; Williamsport, Pennsylvania; Philadelphia, Pennsylvania; and Morrow, Ohio. These depositions, required in order to respond to TriForest's allegations, also resulted in great expense to Nalge, including extensive travel costs and time for counsel to prepare and participate. Counsel for TriForest did not appear at any of these five depositions. In fact, counsel for TriForest did not even request to attend by telephone.

D. TriForest Did Not File Notices Of Reliance

As noted above, TriForest took virtually no action during the discovery and trial testimony periods. Other than a few statements from one of its employee, Mr. Lin, TriForest also did not file any Notices of Reliance. Nalge was forced to file three Notices of Reliance in response to TriForest's allegations, through which Nalge submitted TriForest's responses to Nalge's written discovery requests, and third-party design patents and trademark registrations.

E. TriForest Failed To Respond To Pleadings Filed In This Opposition Proceeding

During his deposition, Mr. Lin of TriForest refused to answer questions regarding the relatively inexpensive costs of manufacturing TriForest's own drinking bottles, prompting Nalge to prepare and file (at additional expense to Nalge) Nalge's Objections to Trial Testimony of Steven Lin and Motion for Determination Adverse to Opposer, in which Nalge requested a determination that the method for manufacturing Nalge's products bearing Nalge's mark is no cheaper or simpler than manufacturing a functionally equivalent drinking bottle. TriForest did not respond to Nalge's Motion.

V. CONCLUSION

Because the arguments made by TriForest in its Reply Brief are wholly unsupported, and the exhibits and other documents referenced by TriForest were not properly admitted during the trial testimony period, Nalge respectfully requests that the Board strike them from the record. Nalge also requests that the Board strike TriForest's reference to Margaret Gregory's testimony, as it violates the Protective Order entered in this case as well as Rule 1.126(d).

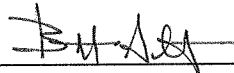
It is clear that TriForest filed this opposition proceeding with no intention of pursuing it in good faith, while avoiding any costs or expenses that would otherwise be required to pursue a legitimate opposition. TriForest even admits in its Reply Brief that it has no intention of appearing at oral argument. (Opposer's Reply Brief, at p. 6). At the same time, TriForest knew, or at least should have known, that Nalge would be forced to defend against TriForest's allegations. The nature of this opposition proceeding forced Nalge to respond to TriForest's allegations and to undertake the discovery and trial testimony and prepare and file the pleadings mentioned above, at significant expense to Nalge.

With respect to TriForest's violations of Rules 11(b) and 12(f) of the Federal Rules of Civil Procedure, as well as TriForest's clear intention of not legitimately pursuing this opposition proceeding, but at the same time forcing Nalge to incur significant expense in defending this matter, Nalge requests that sanctions be levied against TriForest. Specifically, Nalge requests that TriForest's opposition of Nalge's mark be dismissed. Indeed, the fact that TriForest's has wasted Nalge's resources is cause for sanctions. *Central Mfg., Inc. v. Third Millenium Tech., Inc.*, 61 U.S.P.Q. 2d 1210 (TTAB 2001). Nalge recognizes that the Board will likely not order TriForest to pay over to Nalge the expenses and fees it has incurred and will

continue to incur in this opposition proceeding. T.B.M.P. § 502.05. Otherwise, Nalge would request such an order for TriForest and/or its counsel to pay over to Nalge its expenses and fees.

Respectfully submitted,

Dated: March 13, 2007

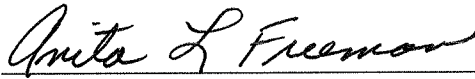


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CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being transmitted electronically to the United States Patent and Trademark Office, Trademark Trial and Appeal Board on the date shown below.

Date: March 13, 2007


Anita L. Freeman

CERTIFICATE OF SERVICE

I hereby certify that the foregoing **APPLICANT NALGE NUNC
INTERNATIONAL CORPORATION'S OBJECTIONS TO AND MOTION TO STRIKE
PORTIONS OF OPPOSER'S REPLY BRIEF AND MOTION FOR SANCTIONS** was
served by United States Postal Service as First Class Mail, postage prepaid, upon counsel for
Opposer TriForest Enterprises, Inc., Clement Cheng, Esq., Law Offices of Clement Cheng,
17220 Newhope Street, Suite 127, Fountain Valley, California 92708, on this 13th day of March,
2007.



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